

## REMARKS

### Claim Status

Claims 11-23 and 29-42 remain for consideration. All claims are thought to be allowable over the cited art.

The grouping of claims 11-23 with claims 29-49 is acknowledged.

### Rejections Under 35 USC §102(e)

The Office Action fails to establish that claims 11-23 are anticipated under 35 USC §102(e) by "Powell" (U.S. Patent No. 6,657,426 to Powell et al.). The rejection is respectfully traversed because the Office Action does not show that all the limitations of the claims are taught by Powell. For example, the Office Action cites limitations of programming specific volumes of ICs with a configuration and packing the IC for shipment as being taught by Powell while failing to address the many other limitations of the claims.

Claim 11 also includes limitations of storing a plurality of configurations, and the Office Action does not cite nor does Powell appear to teach any such plurality of configurations being stored. Furthermore, a specified volume of ICs is pulled in response to an order from a customer. There is no apparent teaching of Powell's system acting in response to an order from a customer, nor does the Office Action cite any teaching as corresponding to these limitations. Still further limitations include programming the specified volumes with a configuration selected by the customer, and these limitations are not addressed by the Office Action.

Claims 12-23 depend from claim 11 and include further limitations that the Office Action fails to address. For example, claim 12 includes attaching a memory device to the FPGAs; claims 13 and 14 include programming the memory device that was attached to the FPGA, claims 15-18 specify different types of the memory device that was attached to the FPGA; claim 19 includes testing the programmed ICs; claim 20 includes labeling the programmed ICs; claim 21 includes tracking sales of the ICs with the specific configuration; claim 22 specifies that the selected configuration is developed by the customer; and claim 23 specifies that the labeling includes a

customer name or a customer logo. The Office Action fails to cite any teachings of Powell as corresponding to these limitations, and no readily apparent teachings of Powell appear to suggest these limitations.

Therefore, claims 11-23 are not shown to be anticipated by Powell.

Rejections Under 35 USC §103(a)

The Office Action fails to establish that claims 11-23 are obvious under 35 USC §103(a) over Powell. The rejection is respectfully traversed because the Office Action does not show that all the limitations are suggested by Powell, does not provide a proper motivation for modifying the teachings of Powell, and does not show that the modifications could be made with a reasonable likelihood of success.

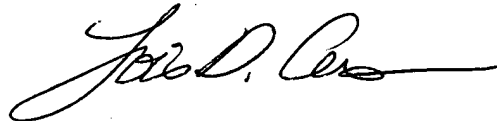
The Office Action takes Official Notice that ICs are shipped to customers with configurations. However, shipping configured ICs to customers bears no apparent motivation to modify Powell in the manner set out by the limitations of claims 11-23 as discussed above. Nor does the Office Action provide any evidence or explanation to support the modifications. Therefore, the rejection of claims 11-23 over Powell should be withdrawn because the Office Action fails to show all the limitations are suggested by Powell, fails to provide a proper motivation for modifying Powell, and fails to show that the modifications could be made with a reasonable likelihood of success.

The Office Action fails to establish that claims 29-42 are unpatentable under 35 USC §103(a) over Powell. Claims 29-42 are system claims in means plus function format. The Office Action does not show that Powell suggests the functions of the claims as explained above. Furthermore, the Office Action does not consider the structure disclosed in the specification in alleging that the claims are unpatentable. ("the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination." *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994) MPEP 2181). Therefore, claims 29-42 are not shown to be unpatentable over Powell.

CONCLUSION

Reconsideration and a notice of allowance are respectfully requested in view of the Amendments and Remarks presented above. If the Examiner has any questions or concerns, a telephone call to the undersigned is invited.

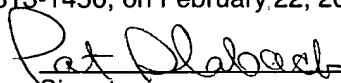
Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patent, P.O. Box 1450, Alexandria, Virginia 22313-1450, on February 22, 2005.

Pat Slaback  
Name

  
Signature